

REMARKS/ARGUMENTS

Reconsideration of this Application and entry of this Amendment is respectfully requested. By the amendments, Applicants do not acquiesce to the propriety of any of the Examiner's rejections and do not disclaim any subject matter to which Applicants are entitled. *Cf. Warner Jenkinson Co. v. Hilton-Davis Chem. Co.*, 41 U.S.P.Q.2d 1865 (U.S. 1997). Claims 1-24 are pending. Claims 3, 4, 6-9, 12, 14-16, 18-21 and 24 have been amended herein. No new matter has been added as a result of the present amendments.

Claims 7-8 and 19-20 have been amended to correct an inadvertent typographical error. The term "anyone of" has been amended to read "any one of."

35 U.S.C. §112 Rejections

Claims 3-8, 15-16 and 18-20 have been rejected under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the written description requirement. In particular, the Examiner has objected to the term "consisting essentially of" with respect to the description of the terpolymer composition. Without acquiescing to the propriety of this rejection, Applicants have amended claims 3 and 15 to describe the composition of the terpolymer (and the bipolymer) using the term "consisting of." The use of this term connotes that the monomer subunits are the only components of the terpolymer or bipolymer. Support may be found throughout the specification, for example, in Table 1 and the various Examples where it is evident that the monomer units of a particular polymer add up to 100%. Claims 4-8, 16 and 18-20 depend from claims 3 or 15 and, as such, are also definite. The Examiner is respectfully requested to withdraw this ground of rejection.

Claims 14 and 19 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Office asserts that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The Applicants respectfully disagree. However, solely in an effort to expedite prosecution and not to acquiesce to the Office's rejection, the Applicants have removed "parylene derivative" from claim 14. As a result of the amendment, the Applicants assert that claim 14 has written support in the specification. Claim 19 is dependent from claim 14, and as such, is also definite. In light of the above, the Applicants request the Office withdraw the 35 U.S.C. §112, first paragraph rejection of claims 14 and 19.

Claims 4, 7-8, 16, and 19-20 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 4 and 16 recite the relative weight percentages of the monomer subunits of the terpolymer. The Office asserts that the relative amounts need to add up to 100% and as such, the ranges recited are indefinite.

In an effort to expedite prosecution and not to acquiesce to the Office's rejection, Applicants have amended claims 4 and 16 to recite "40-74% (AMA)." The relative amounts now add to 100%. Support for this amendment may be found in the penultimate line of Table 1, In light of amended claims 4 and 16, the Applicants assert that claims 4, 7-8, 16, and 19-20 are definite and request withdrawal of the 35 U.S.C. §112, second paragraph rejection.

Claims 6-8 and 18-20 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 6 and 18 recite that the alkyl methacrylate is selected from the group consisting of "methyl, ethyl, propyl, butyl, pentyl, and hexyl." None of the species recited are species of alkyl methacrylates. The Office asserts that they are rather species of alkyl groups.

In an effort to expedite prosecution and not to acquiesce to the Office's rejection, Applicants have amended claims 6 and 18 to recite "wherein said alkyl of said alkyl methacrylate is selected from the group consisting of methyl, ethyl, propyl, butyl, pentyl, and hexyl." The alkyl methacrylates are now properly defined. In light of amended claims 6 and 18, the Applicants assert that claims 6-8 and 18-20 are definite and request withdrawal of the 35 U.S.C. §112, second paragraph rejection.

Claims 9 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner refers to the use of the terms "anti-proliferatives including" and "macrolide antibiotics including FKBP 12 binding compounds." In an effort to expedite prosecution and not to acquiesce to the Office's rejection, Applicants have amended claims 9 and 21 to indicate that both macrolide antibiotics and FKBP 12 binding compounds may be classes of anti-proliferatives. In light of this amendment, Applicants submit that claims 9 and 21 are definite and request withdrawal of this Section 112, second paragraph, rejection.

Claims 11 and 23 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner points out that the language “wherein said FKBP 12 binding compound is a macrolide antibiotic” is inconsistent with the language of claims 9 and 21. Applicants submit that the amendment to claims 9 and 21 discussed above renders this ground of rejection moot. In light of the amendment to claims 9 and 21, Applicants submit that claims 11 and 23 are definite and request withdrawal of this Section 112, second paragraph, rejection.

Claims 12 and 24 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner has pointed out that the terms “A-19” and “A-20” do not describe macrolide antibiotics and that neither the specification nor the claims define what these terms mean. Applicants disagree. These terms are defined in the specification at paragraph [0103] as referring to rapamycin and everolimus, respectively. Applicants have amended claims 12 and 24 to so reflect these names. Accordingly, Applicants submit that claims 12 and 24 are definite and request withdrawal of this Section 112, second paragraph, rejection.

Claims 14 and 19 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner has objected to the use of the term “derivative.” As pointed out above with respect to the rejection of these claims under the written description requirement, Applicants, merely in order to expedite prosecution of this application and not to acquiesce to the Office’s rejection, have amended claim 14 to remove this term. Claim 19 depends from claim 14 and, as such, is also definite. Accordingly, Applicants submit that claims 14 and 19 are definite and request withdrawal of this Section 112, second paragraph, rejection.

35 U.S.C. §103 Rejections

Claims 1-2, 7-13, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyu et al. (Lyu).

Claims 14 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyu in view of Sirhan et al. (Sirhan).

Claims 1-13 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benz et al. (Benz) in view of Shalaby et al. (Shalaby) and Lyu.

Claims 14 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benz, Shalaby and Lyu in view of Sirhan.

Lyu has a publication date of March 11, 2004 and is cited as prior art against the present application under 35 U.S.C. §103 (a) and qualifies as prior art under 35 U.S.C. §102 (e). 35 U.S.C. §103 (c) states, in part:

“35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.

(c)

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” (Emphasis added)

The invention claimed in the present application (serial number 10/595,095) and the Lyu patent application (serial number 10/640,702) were co-owned at the time the presently claimed invention was made. Therefore the provisions of 35 U.S.C. §103 (c) are wholly applicable in the present case and Lyu cannot be cited as prior art.

Statement of Joint Ownership

The invention claimed in the present application (serial number 10/595,095) and Lyu (serial number 10/640,702) were co-owned at the time the presently claimed invention was made.

Facts Supporting the Statement of Joint Ownership

Lyu was filed August 13, 2003 as patent application serial number 10/640,702 and claims priority to Provisional Application 60/403,413 filed August 13, 2002. Lyu is assigned to Medtronic, Inc.; the assignment was recorded in the U.S. Patent and Trademark Office (USPTO) on August 13, 2003, reel and frame number 014405/0375.

The present application, serial number 10/595,095, was filed on February 9, 2006 as a US National Stage Application under 35 U.S.C. 371 of Application PCT/US04/26516 filed August 12, 2004 which claims priority from Provisional Application 60/495,143 filed August 13, 2003; the assignment of the PCT application to Medtronic Vascular, Inc. was originally executed by all the inventors between July 20, 2004 and August 2, 2004. A copy of this notarized assignment is attached hereto as an Appendix. Medtronic Vascular, Inc. is a wholly owned subsidiary of Medtronic, Inc. Thus, at the time the presently claimed invention was made, it was owned by the same person or subject to an obligation of assignment to the same person that owned Lyu.

The remaining references individually or in combination do not teach each and every limitation of the presently amended claims. The Applicants respectfully assert that a skilled person could not, based on the remaining references, arrive at the present invention.

In light of the above, Lyu is not available as prior art and the Office has not established a *prima facie* case of obviousness. As such, the Applicants request the Office withdraw the 35 U.S.C. §103(a) rejections and the present application be allowed.

Conclusion

For the foregoing reasons, Applicants believe all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-5021.

Respectfully submitted,

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Registration No. 26,289
Attorney for Applicants

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Santa Rosa, CA 95403
Facsimile No.: (707) 543-5420

Application No. 10/595,095
Amd. Dated: February 15, 2010
Reply to Office Action mailed November 19, 2009

APPENDIX

ASSIGNMENT

WHEREAS, We, Kishore Udi, Peiwen Cheng, Shalaby W. Shalaby, Todd D. Campbell and Su Ping Lyu, are the inventors of "BIOCOMPATIBLE CONTROLLED RELEASE COATINGS FOR MEDICAL DEVICES AND RELATED METHODS", herewith executed by the undersigned on the date written below; and

WHEREAS, MEDTRONIC VASCULAR, INC. a Delaware corporation having a place of business at 3576 Unocal Place, Santa Rosa, California 95403 hereinafter referred to as "ASSIGNEE," is desirous of acquiring the entire right, title and interest in and to said invention for the United States and for all foreign countries and in and to any and all foreign and domestic Letters Patent which may be granted therefore;

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, I have sold, assigned, transferred and set over and by these presents do sell, assign, transfer and set over unto ASSIGNEE, its successors and assigns, the entire right, title and interest in and to said invention and the entire right, title and interest in and to any and all Letters Patent of the United States and any foreign countries which may be granted therefore including my rights under the International Convention for the Protection of Industrial Property, and in and to any and all extensions, divisions, continuations, continuations-in-part or reissues of said Letters Patent that may be granted, the same to be held and enjoyed by ASSIGNEE for its own use and behoof and use and behoof of its successors and assigns to the full end of the term for which said Letters Patent may be granted, as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made;

AND, for the consideration aforesaid, I materially represent to ASSIGNEE, its successors and assigns, that at the time of the execution and delivery of these presents, I am the sole lawful owners of the entire right, title and interest in and to the invention, application and Letters Patent above mentioned, and that the same are unencumbered, and that I have good right and lawful authority to sell and convey the same in the manner herein set forth;

AND, for the consideration aforesaid, I hereby individually covenant and agree to and with ASSIGNEE, its successors and assigns, that whenever its counsel or the counsel of its successors or assigns, learned in the law, shall advise that an amendment or division of, or continuation or any continuation-in-part thereof, or any other proceeding in connection with the filing or prosecution of said domestic or foreign patent applications, including interference proceedings, is lawful and desirable, or that a reissue or extension of said Letters Patent is lawful and desirable, I, or my executors, administrators or assigns will sign all papers and drawings, take all rightful oaths, and do all acts necessary or required to be done for the procurement of valid Letters Patent for said invention, or for the reissue or extension of the same, without charge to ASSIGNEE, its successors or assigns, but at ASSIGNEE'S expense.

I hereby request the Honorable Commissioner of Patents and Trademarks to issue the Letters Patent to Corporation in accordance with this instrument.

IN WITNESS WHEREOF, I have hereunto set my hand on this twentieth
day of July, 2004.

Kishore Udipli
Kishore Udipli

STATE OF California

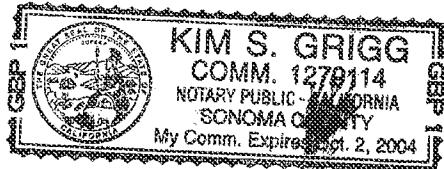
ss.

COUNTY OF Sonoma

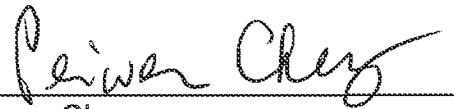
On this 20th day of July, 2004, before me personally appeared Kishore Udipli to me known to be the person described in and who executed the foregoing instrument and acknowledged that he executed the same as his free act and deed.

IN WITNESS WHEREOF, I have hereunto affixed my official signature with the seal of my office, the day and year above written.

K. S. Grigg
Notary Public



IN WITNESS WHEREOF, I have hereunto set my hand on this 20th day of
July, 2004.


Peiwen Cheng

STATE OF California

COUNTY OF Sonoma ss.

On this 20th day of July, 2004, before me personally appeared Peiwen Cheng to me known to be the person described in and who executed the foregoing instrument and acknowledged that he executed the same as his free act and deed.

IN WITNESS WHEREOF, I have hereunto affixed my official signature with the seal of my office, the day and year above written.




Kim S. Grigg
Notary Public

IN WITNESS WHEREOF, I have hereunto set my hand on this 26th day of
July, 2004.

Shaleby W. Shalaby
Shaleby W. Shalaby

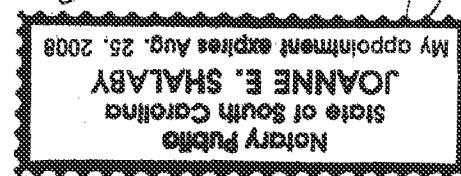
STATE OF South Carolina

COUNTY OF Anderson ss.

On this 26th day of July, 2004, before me personally appeared Shaleby W. Shalaby to me known to be the person described in and who executed the foregoing instrument and acknowledged that he executed the same as his free act and deed.

IN WITNESS WHEREOF, I have hereunto affixed my official signature with the seal of my office, the day and year above written.

Jeanne E. Shalaby
Notary Public



IN WITNESS WHEREOF, I have hereunto set my hand on this 2nd day of
August, 2004.

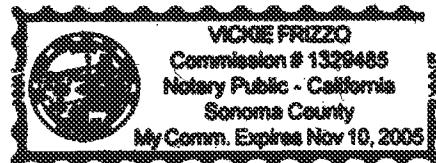


Todd D. Campbell

STATE OF CALIFORNIA

COUNTY OF Sonoma

ss.



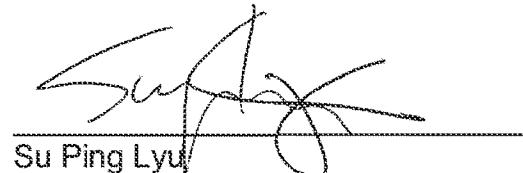
On this 2nd day of AUGUST, 2004, before me personally appeared Vickie Hugo to me known to be the person described in and who executed the foregoing instrument and acknowledged that he executed the same as his free act and deed.

IN WITNESS WHEREOF, I have hereunto affixed my official signature with the seal of my office, the day and year above written.



Vickie Hugo
Notary Public

IN WITNESS WHEREOF, I have hereunto set my hand on this 21st day of
July, 2004.



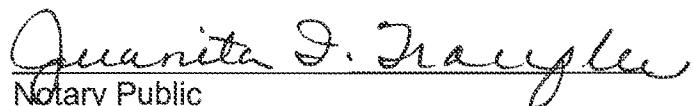
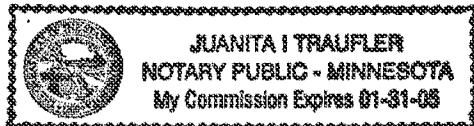
Su Ping Lyu

STATE OF MINNESOTA

COUNTY OF Anoka ss.

On this 21st day of July, 2004, before me personally appeared Su Ping Lyu to me known to be the person described in and who executed the foregoing instrument and acknowledged that he executed the same as his free act and deed.

IN WITNESS WHEREOF, I have hereunto affixed my official signature with the seal of my office, the day and year above written.



Juanita I. Traufler

Notary Public